

### **REMARKS**

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the specification and claims and the following remarks.

#### ***Amendments to Specification***

The trademarks have been capitalized and accompanied by generic terminology as suggested by the Examiner.

#### ***Amendments to Claims***

Upon entry of the present amendment, claims 1 and 12-36 will be pending in the above-identified application with claims 1, 12-16, and 34-36 standing ready for further action on the merits and remaining claims 17-33 being withdrawn from consideration based on an earlier restriction requirement of the Examiner. Claims 1 and 13 have been amended, and claims 2-11 have been canceled. Claims 34-36 have been added.

The present amendments to claims 1 and 13 do not introduce new matter into the application as originally filed. Support for the recitations in claim 1 can be found in claim 3 as originally filed as well as in the present specification, *inter alia*, at page 5, lines 21-22, page 8, lines 18-20, and the examples. Support for the recitations in claim 13 can be found in the present specification, *inter alia*, at page 5, line 6. Support for new claim 34 can be found in claims 4-7 as originally filed. Support for new claim 35 can be found in claim 8 as originally filed. Support for new claim 35 can be found in the present specification, *inter alia*, at page 16, lines 15-17. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

***Specification***

The Examiner notes that the trademarks in the application should be capitalized wherever they appear and be accompanied by the generic terminology. Applicants have amended the present specification in accordance with the Examiner's instructions. Accordingly, Applicants respectfully submit that this issue has been overcome.

***Claim Rejections under 35 U.S.C. § 112***

Claim 13 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that the claim does not explicitly recite the units for the difference in color hues of the powder coatings. Applicants respectfully traverse in view of the amendment to claim 13.

Applicants have amended claim 13 to recite that the lightness is measured "in terms of L\* value." Applicants respectfully submit that the amendment overcomes the outstanding rejection and that the rejection be removed.

***Claim Rejections under 35 U.S.C. § 103***

1) Claims 1 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Klaren '035** (US 3,842,035).

2) Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Klaren ‘035** in view of **Matsumoto et al. ‘226** (US 2002/0156226).

3) Claims 3-4 and 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Klaren ‘035** in view of **Matsumoto et al. ‘226** and *Evonik Industries Product Information*.

4) Claims 5 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Klaren ‘035**, **Matsumoto et al. ‘226**, and *Evonik Industries Product Information* in view of **Itoh et al. ‘727** (US 4,046,727).

5) Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Klaren ‘035**, **Matsumoto et al. ‘226**, and *Evonik Industries Product Information* in view of **Itoh et al. ‘727** and **Okada et al. ‘916** (WO 2001/072916).

6) Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Klaren ‘035**, **Matsumoto et al. ‘226**, and *Evonik Industries Product Information* in view of **Itoh et al. ‘896** (US 5,439,896).

7) Claims 12-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Klaren ‘035** in view of **Itakura et al. ‘145** (US 6,146,145).

8) Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Klaren ‘035** in view of **Sato et al. ‘694** (EP 0,950,694).

9) Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Klaren ‘035** in view of **Shiomi et al. ‘349** (US 5,523,349).

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

*Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) combining prior art elements according to known methods to yield predictable results;
- (b) simple substitution of one known element for another to obtain predictable results;
- (c) use of known technique to improve similar devices (methods, or products) in the same way;
- (d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (e) “obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success

(f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

*Distinctions over the Cited Art*

The present invention provides a powder coating composition comprising two powder coatings each having different gelation time from which a matte coating film can be obtained. Further, by using a powder coating without containing a colorant as one of the powder coatings, it is not necessary to prepare the matte colored powder coatings for every necessary color. Thus, the matte coating film can be easily obtained using an ordinary colored powder coating not for use in the matte coating film (see page 4, lines 18 – 21 of the present specification).

In stark contrast, **Klaren '035** discloses a powder coating composition comprising powder coatings each having different gelation times from which a matte coating film can be obtained. **Klaren '035**, however, does not disclose combining a powder coating containing a colorant and a powder coating without containing a colorant.

Moreover, in **Klaren '035**, gelation time is adjusted by controlling the amount of accelerator (see col. 4, lines 7-10 and col. 5, lines 56-60). Whereas, in the present invention, the amount of a curing catalyst, such as a zinc catalyst or an imidazole catalyst, is not so different between the powder coating (A) and the powder coating (B).

As amended, claim 1 recites, *inter alia*, that:

*the powder coating (A) comprises a polyester as a resin and a blocked isocyanate which is blocked with ε-caprolactam as a curing agent and the powder coating (B) comprises a polyester as a resin and a blocked isocyanate which is blocked with at least one blocking agent selected from the group consisting of methyl isobutyl ketone oxime, methyl ethyl ketone oxime, 1,2-pyrazole, 3,5-dimethylpyrazole, 1H-1,2,4-triazole, 1H-1,2,3-triazole, 1H-1,2,4-triazole-3-thiol, and 1H-1,2,3-triazolo[4,5-b]pyridine as a curing agent (emphasis added).*

One of ordinary skill in the art would know that the dissociation reaction of the blocked isocyanate cannot be adjusted by controlling the amount of a curing catalyst. Accordingly, in the present invention, the blocking agent is limited to ε-caprolactam in the powder coating (A) and to at least one blocking agent selected from the group consisting of methyl isobutyl ketone oxime, methyl ethyl ketone oxime, 1,2-pyrazole, 3,5-dimethylpyrazole, 1H-1,2,4-triazole, 1H-1,2,3-triazole, 1H-1,2,4-triazole-3-thiol, and 1H-1,2,3-triazolo[4,5-b]pyridine in the powder coating (B) while increasing the speed of the dissociation reaction of the blocked isocyanate in the powder coating (B) in comparison with that in the powder coating (A) (see examples). One of ordinary skill in the art would know that the dissociation temperature differs by changing the kind of the blocking agent while using the same kind of isocyanate. Thus, curing time is changed.

As noted above, the present invention provides a different way to make a difference in the gelation time between the two powder coatings from that of **Klaren '035**.

Furthermore, as pointed out by the Examiner, **Klaren '035** teaches a matte powder composition comprising a powder coating comprising an acrylic resin or epoxy resin. Whereas, in the present invention, the resin of the powder coating is limited to polyester. **Klaren '035** fails to disclose this element.

The present invention relates to a matte powder coating composition which contains polyester as a resin and adjusts gelating time of the two powder coatings by combining them with the curing agent. Accordingly, the present invention is not obvious over **Klaren '035**. None of the other cited prior art overcome the deficiencies of **Klaren '035**.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be disclosed by the prior art. As discussed above, the cited references fail to disclose all the claim limitations of independent claim 1, and those claims dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejections is respectfully requested.

For the reasons given above, the combination of references does not render the present invention obvious because the cited references do not disclose at least one feature of the present invention and its effects. Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Any contentions of the USPTO to the contrary must be reconsidered at present.

### ***Double Patenting Rejection***

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 10 of copending Application No. 11/344,009 in view of **Klaren '035**. Applicants respectfully traverse this rejection for the following reasons.

Applicants respectfully submit that the present application is the earlier filed application of the present application and the '009 Application. Also, this rejection is a provisional rejection for non-finalized claims between two applications, and if this rejection is the only rejection remaining in this application, Applicants respectfully submit that this rejection should be withdrawn. See MPEP 804.

***Newly Proposed Claims 34-36***

Applicants have newly proposed claims 34-36 in an effort to further define the scope of protection owed to Applicants. Applicants respectfully submit that claims 34-36 are allowable for the reasons given above.

With specific respect to claim 34, the gelating time of the powder coating (B) can be further shortened by further mixing with an acrylic resin having an epoxy group as a resin and a compound having a carboxyl group as a curing agent because the use of both kinds of resin and different kinds of curing agents can increase curing speed.

For the reasons given above, Applicants respectfully assert that claims 34-36 clearly define over the prior art of record, and an early action to this effect is earnestly solicited.



**CONCLUSION**

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1, 12-16, and 34-36 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: December 4, 2008

Respectfully submitted,

By

John W. Bailey

Registration No.: 32,881

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants